

Hearing:
December 3, 2003

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gene Link, Inc.

v.

Genelink, Inc.

Cancellation No. 92030200
against Registration No. 1956014

Douglas W. Wyatt and John J. Caslin, Jr. of Wyatt Gerber &
O'Rourke, L.L.P. for Gene Link, Inc.

John Lezdey and David Lammey of John Lezdey & Associates for
Genelink, Inc.

Before Hohein, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Genelink, Inc. owns a registration on the Principal
Register for the service mark as shown below:



registered for "DNA testing and storage of DNA material for medical diagnostics and identity testing," in International Class 42.¹

Gene Link, Inc. seeks cancellation of this registration based upon its allegations of having adopted the trademark GENE LINK prior to any date on which the respondent made use of its GENELINK mark, and has used it continuously "for services and products for DNA synthesis, gene identification (testing), mutation analysis, gene localization, gene mapping, gene construction, gene mutagenesis, DNA sequencing, cloning and all other areas of genetic research and development including instrumentation, computing and software." Petitioner argues that respondent's mark so resembles its previously used mark as to be likely, when used on or in connection with the services of the registrant, to cause confusion, or to cause mistake, or to deceive.

Respondent, in its answer, has denied all the salient allegations of the petition to cancel.

The record includes the pleadings; the file of the involved registration; and, as petitioner's case-in-chief:

¹ Reg. No. 1956014 issued on February 13, 1996 from an application filed on December 15, 1994 which sets forth dates of first use anywhere and in commerce at least as early as November 29, 1994.

the testimony deposition, with exhibits, of Ali A. Javed, petitioner's chairman of the board; and a notice of reliance upon, *inter alia*, respondent's annual report filed with the Securities and Exchange Commission; and as respondent's case-in-chief, the trial testimony deposition, with attached exhibits, of respondent's chairman of the board, chief executive officer and president, John R. DePhillipo.

At oral hearing, and in its brief, petitioner complained about not being served with a copy of the transcript of Mr. DePhillipo's testimony. While respondent clearly should have served petitioner in a timely manner with a copy of the transcript of this testimony,² we find that petitioner has waived its right to so object by not timely filing a motion for relief under 37 C.F.R. §2.125(a).

As a preliminary matter, respondent argues that "[t]he Section 8 and 15 affidavit for Respondent's registration GENELINK has been accepted by the Patent and Trademark Office so as to be incontestable." (Respondent' brief, p.

² Trademark Rule 2.125(a) provides in relevant part that: "One copy of the transcript of testimony ... shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the ... Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate..."

2). However, this appears to be neither a correct statement of the facts nor an accurate reading of the law.

Whenever a party seeks to cancel a mark registered on the Principal Register, under Section 14 of the Trademark Act, 15 U.S.C. §1064, the petitioner must raise priority of use and likelihood of confusion in a petition filed within five years of the date of registration. Accordingly, inasmuch as the five-year anniversary of the issuance of the involved registration was February 13, 2001, the instant cancellation petition was timely filed on March 28, 2000.

Finally, any questions related to incontestability have nothing to do with petitioner's grounds for cancellation of the involved registration. Moreover, we note that the papers that respondent filed on February 20, 2001 contained a combined Section 8 declaration of continued use in commerce as well as a Section 9 renewal application - *not* a Section 15 affidavit or declaration of incontestability.

The issues to be decided in this proceeding are which party has priority of use of its mark and, if priority lies with petitioner, whether there is a likelihood of confusion from contemporaneous use of the parties' marks in connection with their respective goods and/or services.

We find that petitioner has established its priority but has failed to demonstrate a likelihood of confusion.

Turning first to the determination of priority, the record shows that petitioner has continuously used its GENE LINK mark in connection with products used by genetics researchers and scientists (e.g., custom oligonucleotide products synthesized for gene identification, DNA sequencing and analysis, mutation analysis, gene mutagenesis, cloning, etc.), since January 1994 when it adopted and commenced use thereof with respect to a shipment of product to the Winifred Masterson Burke Medical Research Institute in White Plains, NY. (Javed Trial Deposition at 15 - 17, Exhibit 5) This followed immediately on the heels of the incorporation of Gene Link, Inc. in December 1993. (Javed Trial Deposition at 13 - 14, Exhibit 3) The record shows that petitioner had sales of more than \$141,000 during the year 1994 with a continuous stream of product sales to research universities, hospitals and pharmaceutical companies. (Javed Trial Deposition at 17 - 53, 78 - 79) Over the years since 1994, petitioner has added an ever-growing array of products, and then in the year 1999, added services by providing its customers with customized products.

Respondent argues that petitioner's early use was only as a trade name, not as a trademark for its goods:

Petitioner's early use of the term GENE LINK was as a firm name only and functioned only to identify the producer of the chemical

compounds. The term was not used for the purpose of identifying the source of the goods. Petitioner instead used either Linkmer, Fragile X Gene Probe, GENEMER and catalog numbers. The term GENE LINK as used by Petitioner was to distinguish the Petitioner from other producers rather than for the purpose of naming a source of the good so that it was merely tradename [sic] use. (See In re Walker Process Equipment Inc., 233 F.2d 329, 110 USPQ 41 (1956)).

(Respondent's trial brief at pp. 4 - 5) We disagree with this contention. Dr. Javed's testimony and accompanying product labels show valid trademark usage on each tube of product sent out from the very beginning of petitioner's business. From 1994 through 1999, petitioner sold only products, all of which contained labels having its GENE LINK trademark along with its accompanying logo:



Then, beginning in 1999, petitioner began offering custom DNA sequencing - a service - under its GENE LINK mark. Petitioner continued to offer both goods and services under its GENE LINK mark through the time the record closed in this proceeding, achieving annual gross revenues of \$1.7 million by the years 2000 and 2001.

On the other hand, in the fall of 1994, while respondent possessed proto-type kits for the non-invasive collection of human DNA, and was engaged in a dialogue with

Mr. William Parisi about becoming a distributor for its kits, the record fails to document any sales of its kits during 1994, or of any other incidents of its services of providing for the collection and storage of DNA materials.

Specifically, Mr. DePhillipo testified to respondent's initial sales in September of 1994, as follows:

- Q. (Mr. Lezdey): Was there a time when you made a sale in 1994?
- A. (Mr. DePhillipo): Yes, we did. We sold 5,000 kits to a William Parisi.
- Q. Can you tell us at the time when the sale was made?
- A. The sale -- well, I have -- the sale was made in September 20th, 1994.

(DePhillipo Trial Deposition at 7 - 8) However, Mr. DePhillipo's letter of September 20, 1994 to Mr. Parisi contains the following as its penultimate paragraph:

The minimum order we discussed is 5,000 Kits, at our agreed price to you of \$65.00 per kit, with a suggested retail price of \$175.00. Upon signing of the agreement and payment, Kits will be shipped within 60 days.

(DePhillipo Trial Deposition Exhibit 102) The record contains no evidence of the signed agreement or payment, and DePhillipo's testimony and accompanying documents show that Parisi executed a confidentiality agreement resulting in respondent sending Parisi a single sample kit during October 1994. Correspondence between DePhillipo and Parisi about test marketing the kits to two hundred birth hospitals in

New York, New Jersey and Pennsylvania demonstrates no more progress toward a signed agreement, payment or the shipment of an order of goods. While respondent's mark is shown on letterhead during this period, the record is totally devoid of any proof of actual sales of the kits in 1994, or of any other incidents of its services of providing for the testing and storage of DNA materials.

In fact, the claimed date of first use (November 29, 1994) contained in the application papers that resulted in the involved registration is not supported anywhere in this record, and on cross-examination, respondent's primary witness was unable to provide any support for its claimed first use date:

- Q. (Mr. Wyatt): Your trademark application indicates your date of first use. Do you recall what those dates were?
- A. (Mr. DePhillipo): No, I don't, counselor.
- Q. Okay. Then let me refresh your recollection by showing you your answers to your interrogatories I'm going to show -- these are -- I'm handing you what are copies of your answers to the first set of interrogatories, and in answer to Interrogatory Number 2, the question is: Describe the nature of respondent's business from the date of the adoption by respondent of the mark GeneLink, and any invariance [sic] thereof, which may be earlier to the present. Answer: Services in connection with DNA testing and storage of DNA material for medical diagnostics and identity testing. And then you

say: Document December 8th, 1994,
trademark application, filing receipt
for trademark application listing date
of first use of 11/29/94.

- A. Uh-huh.
- Q. Do you remember that date?
- A. Well, I'm reading. I don't recall it,
but it's seven years ago, but I assume
that's correct.
- Q. Is that a correct date as far as you're
concerned?
- A. Yes.
- Q. Okay. How was it used at that time?
- A. How was our -
- Q. How did you use the mark GeneLink at that
time --
- A. Well --
- Q. -- 11/29/94?
- A. Well, if we start - I'll start with
these. We had a logo designed, and I'm
holding up the October 24, '94 letter
to William Parisi. We used our name in
various letters to potential
distributors. We used our name to
various press organizations. We used
our name in soliciting the government's
offices for DNA -- for the military's
DNA storage. We had written to several
funeral -- the funeral industry. We
used our name there on a national basis
to many different states where there
were known large funeral homes; private
practice physicians; dentists;
hospitals; insurance companies; DNA
testing laboratories; adoption
agencies...

(DePhillipo Trial Deposition at 38 -40) On cross-
examination, Mr. DePhillipo admitted that he had no
documentation to support the storage of any DNA materials at
the University of North Texas Health Science Center prior to
June 21, 1995. (DePhillipo Trial Deposition at 77 - 79)

We find, in light of the above, that there is no question from this record but that petitioner has priority of use of its marks in connection with its products.

We turn then to the issue of likelihood of confusion under Section 2(d) of the Trademark Act. This determination must be based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also In re Azteca Restaurant Enterprises, Inc., 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

With respect to the marks, we find that the trademarks of the parties are substantially identical. While the registered mark has a design feature where an image of a baby in a stroller is "linked" to the representations of each parent with a design feature representing a double helix strand of DNA material, the only portion of the mark that can be spoken is the term GENELINK. In most instances

where respondent's mark appears in the record, it is shown as a word mark. In addition to the obvious visual similarity between the parties' marks, the sound of the two marks is therefore identical.

As to meaning, respondent explained the origins of the LINK portion of its mark as stressing that genetics "link" each individual to one's family's medical histories. This is reinforced by the design imagery. Petitioner explains linkage in the context of scientific analyses of how specific genetic disorders may be tied to separate gene markers near or within a gene of interest. However, in either case, the connotation suggests the process of using human genetics to track heritable traits within a family. Hence, judging by the sight, sound and meaning trilogy, we find that each comparison results in a finding of confusingly similar marks.

With respect to the goods and services of the parties, the record reveals that petitioner is a biotechnology company that directs its products and services to genetics researchers and scientists located in universities, research institutes, pharmaceutical companies and research hospitals. According to a press release contained in the record:

Gene Link is a leading supplier of custom oligonucleotides for use in PCR, sequencing, cloning, ligation, and sequence mutagenesis.

GeneLink offers all modifications, as well as a wide variety of other molecular biology products such as linkers, adaptors, etc. GeneLink also has a research and development department dedicated to discovering new techniques and methods leading to better quality products.

Gene Link is in the process of developing research products to aid scientists with detection of genetic disorders ...

(Javed Trial Deposition at 72 - 74, Exhibit 40) As shown by petitioner's records, generally research scientists submit orders for goods or services directly to petitioner via email, fax, etc. Upon shipment of the goods or provision of the services, petitioner sends invoices to the institutions that employ the research scientists. At some later point, petitioner receives payment from the university, research institute, pharmaceutical company or research hospital.

(Javed Trial Deposition at 18 - 53, Exhibits 6 - 26)

Petitioner has advertised its goods and services in periodicals such as Biotechniques Journal, Genetics Engineering News, Cell and Nature Genetics. All of these magazines are directed to bio researchers. (Javed Trial Deposition at 65, 75 - 77, Exhibits 36 & 42) Petitioner has made appearances at the New York Human Genetics Club, the American Society of Human Genetics and the International Society of Human Genetics. (Javed Trial Deposition at 66 - 68, Exhibits 37 - 38) Throughout its entire history,

petitioner's goods and services have been directed to biomedical research - not medical diagnosis.

Respondent offers its DNA collection and banking services to individuals who are members of the general public. Its most successful sales efforts to date have been the sale of its kits through the cemetery and cremation markets. The purchase of a DNA collection kit includes the storage of DNA material for an agreed-upon period of time. Respondent is able to offer to its customers long-term storage of an individual's DNA through a contract with a medical laboratory facility in Texas - the University of North Texas Health Science Center at Fort Worth. To the extent that customers want to have the stored DNA analyzed at some later date, this is a new service for which additional fees are required, but at that point respondent makes the stored DNA sample available for genetic testing and analysis by DNA labs such as Athena Diagnostics or Myriad Genetics. (DePhillipo Trial Deposition at 99)

At first blush, these goods and/or services appear to be related inasmuch as the technologies involved herein are both tied closely to genetic testing of human DNA. Petitioner provides technology support for genetic testing in the field of biotechnology while respondent provides for the collection of DNA samples so that families can later

utilize gene technologies to secure medical and genetic information. Both parties' services contain the capabilities of detecting alterations related to a heritable disorder.

We note that petitioner does not discuss in detail why these services and goods are closely related, nor does petitioner specify the class of common purchasers who are likely to be confused. Rather, petitioner argues that the issue of likelihood of confusion must be determined on the basis of the services as they are identified in the involved registration, rather than on what any evidence may show as to the actual nature of the goods, their channels of trade and/or classes of purchasers. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and In re Elbaum, 211 USPQ 639 (TTAB 1981). It is true that respondent's registration has a recital of services broader than the evidence reviewed above shows its actual scope of services to be: "DNA testing and storage of DNA material for medical diagnostics and identity testing." Apart from the specific context of respondent's actual business operations, its recited service of providing "DNA testing for medical diagnostics" appears to be somewhat related to petitioner's gene testing, mutation analysis, gene mutagenesis, and other areas of genetic research.

Petitioner would seem to be equipped to do much the same kind of genetic testing and analysis being done for respondent's customers by DNA labs such as Athena Diagnostics or Myriad Genetics. Conversely, respondent's DNA banking facility at the University of North Texas Health Science Center at Fort Worth would appear to be a primary target audience for petitioner's marketing of its goods and services. Respondent's specimens of record and petitioner's press release (Exhibit 40, *supra*) both refer to "PCR" (polymerase chain reaction) technologies.

On the other hand, there are glaring differences between the parties' goods and services. Petitioner's goods involve cutting-edge technology directed to molecular biologists. While focused totally on medical research, petitioner is clearly not involved in medical diagnosis. By contrast, respondent's kits each involve half-a-dozen cotton-tipped swabs and the promise of freezer storage of a loved one's DNA material for some potential utility in the future. There is no evidence that respondent's collection kits would be sold to, or used by, genetic researchers to collect DNA samples. The sale of respondent's kits seems inextricably tied into the later, long-term storage of the DNA materials. Petitioner markets its goods to research scientists while respondent markets its goods to grieving

family members through a funeral director. Accordingly, as to the similarity or dissimilarity and nature of the goods or services as described in the registration and in connection with which the prior mark is in use, based upon all the evidence contained in this record, we find that petitioner's goods and services are not so closely related that confusion would be likely from contemporaneous use of these virtually identical marks.

As for the du Pont factor having to do with instances of actual confusion, petitioner has documented a number of misdirected inquiries intended for respondent. These misdirected emails and other correspondence provide some support for petitioner's arguments that the marks are confusingly similar. On the other hand, most of the emails involved the concerns of respondent's anxious investors who contacted petitioner at www.genelink.com, not prospective customers of either party. In most of the instances where misdirected letters reached petitioner, petitioner's chairman was able to discern quickly from the context that the correspondence had been misdirected. Hence, this evidence does not weigh strongly in petitioner's favor.

As to the similarity or dissimilarity of established, likely-to-continue trade channels, as noted above, the channels of trade appear to be quite different. Petitioner

markets its goods and services to biomedical researchers and scientists who are looking for very specific, high-technology tools. Respondent appears to rely almost exclusively on funeral directors to market its decidedly lower-technology goods to grieving family members.

As to the conditions under which and buyers to whom sales are made, it seems that petitioner's customers are the prototype of careful, sophisticated purchasers. If perchance one of them were to encounter respondent's services at the local mortuary, we find nothing in this record that would make us conclude that they would form the mistaken impression that this service originated with, or had the imprimatur of, petitioner.

In conclusion, we find that petitioner has met its burden of demonstrating that it has a priority of use. However, in spite of the virtual identity of the marks at issue, upon consideration of the other pertinent du Pont factors, we also find that petitioner has failed to demonstrate by a preponderance of the evidence that confusion as to source or sponsorship from contemporaneous use of the parties' marks in connection with their respective goods and services is likely to occur.

Decision: The petition to cancel is denied.